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In The Supreme Court Of The United States

OCTOBER TERM 1995

DAN CHASE TAXIDERMY SUPPLY COMPANY, INC. and DAN CHASE,

Petitioners,

V.

SUPERIOR FORM BUILDERS, INC.,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

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REPLY TO BRIEF IN OPPOSITION

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REPLY BRIEF OF PETITIONERS

INTRODUCTION

Notning could better illustrate the immediacy of the issues presented here than two opinions handed down on these same questions by two Circuit Courts of Appeals while this case was being briefed. The continuing development of the law in divergent directions in the different circuits on the issues of the copyrightability of useful articles and the merger of idea and expression underscores the need for this Court to grant the petition here.

On March 5, 1996, the United States Court of Appeals for the Tenth Circuit decided the case of *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280 (10th Cir. 1996), holding that the basic and utilitarian aspects of a wooden doll could not be copyrighted. *Id.* at 1287.

On June 26, 1996, the United States Court of Appeals for the Second Circuit decided the case of *Hart v. Dan Chase Taxidermy Supply Co., Inc.*, --- F.3d ---, 1996 WL 346330 (2d Cir., June 26, 1996),[1] vacating the judgment below and remanding the case because the district court failed to conduct an analysis of the merger of idea and expression. --- F.3d at ---, 1996 WL 346330, at *3. Appellees in *Hart*, like Petitioners here, cited the earlier case of *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985), relating to department store mannequins, as authority that taxidermy mannequins were not copyrightable due to the merger of idea and expression. The opinion in *Hart* rejected this reading of *Carol Barnhart*, and held, contrary to the opinion below in this case, that ordinary taxidermy mannequins are copyrightable. Thus, the decision resolved an apparent conflict, but in doing so raised another, sharper conflict between the circuits on the question of copyrightability.

Both *Country Kids* and *Hart* emphasize the critical nature of the analysis of the merger of idea and expression to correct application of copyright law. The court in *Country Kids* adapted the "abstraction-filtration-comparison" test developed for use in the context of alleged infringement of computer software. 77 F.3d at 1284. The court in *Hart* remanded the case with a detailed instructions on the procedure that the district court should follow in conducting its analysis. --- F.3d at ---, 1996 WL 346330 at *3. The contrasting methodologies, particularly the failure of the court below to conduct meaningful analysis, points to another issue calling for the attention of the Court in this important area of federal law.

Respondent and amicus argue that there is no conflict among the circuits in the application of the Copyright Act and that the law was correctly applied by the court below . These cases demonstrate that these arguments cannot be maintained.

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[1]A copy of this opinion is being lodged with the Clerk for the convenience of the Court until its publication.

ARGUMENT

I. The Failure of the Court Below to Analyze Respondent's Mannequins to Separate Non-Protectable Ideas From Copyrightable Expression Misapplied the Law and Disregarded Established Practice in Other Circuits.

Petitioners contend that a separability analysis, that is, an analysis of the product in question to distinguish those portions which are inherent and inseparable from the idea from the elements, if any, which are protectable by copyright, is a fundamental and necessary step in the correct application of the law. The failure of the court below to conduct such an inquiry stands in stark contrast to the importance placed on this step by other circuits applying the Copyright Act.

The *Hart* case involved taxidermy mannequins for mounting fish. The court recognized that mannequins straddle the line between utilitarian and sculptural works. --- F.3d at ---, 1996 WL 346330 at *2. The court held that the trial court's failure to conduct an analysis of the merger or separability of idea and expression was reversible error. *Id.* at *3. The court explained the principle as follows:

> The fundamental copyright principle that only the expression of an idea and not the idea itself is protectable has produced a corollary maxim that even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself.

--- F.3d at ---, 1996 WL 346330 at *2.

Essentially, the merger inquiry asks whether all taxidermy mannequins, no matter how artistic they might be, will necessarily be "substantially similar". If this is so, there

is no unique expression to protect under the copyright laws. 1996 WL 346330 at *2. Copyright litigation typically involves two inquiries: whether there is a valid copyright, and if so, whether it has been infringed. *See Country Kids*, 77 F.3d at 1284. Although the concept of merger of idea and expression and thus the necessity for conducting separability analysis arises in the context of copyrightability, the *Hart* court indicated its strong preference for considering the issue whether an idea inevitably merges with its expression in the context of the infringement inquiry. --- F.3d at ---, 1996 WL 346330 at *2.

Similarly, the court in *Country Kids* found it useful to apply the "abstraction-filtration-comparison" test. 77 F.3d at 1284-85. At the abstraction step, the court separates the ideas and basic utilitarian functions which are not protectable from the particular expression of the work. Then the court filters out the non-protectable components of the product from the original expression. Finally, the court compares the remaining protective elements to the allegedly copied work to determine if the two works or substantially similar. *Id.* Thus, the test involves a similar blending of the copyrightability and infringement inquiries as in *Hart*.

As another court has noted, in a realistic portrayal of a deer, most of the features are supplied by the deer. *Concrete Machinery Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 607 (1st Cir. 1988). A separability analysis is mandated to determine if there are protectable elements in the work. *Id.* at 608. The *Concrete Machinery Co.* court called the process "dissection". *Id.*

Respondent argues that the court below did in fact conduct a separability analysis. Respondent relies on the statement in the opinion that the court "believed" the function of the mannequins to be conceptually separable from the works' sculptured features. *See* Pet. App. 25(a); *Superior Form Builders v. Dan Chase Taxidermy Supply Co., Inc.*, 74 F.3d 488, 494 (4th Cir. 1996). This hardly rises to the level of rigor expected by the courts in *Hart*, *Country Kids*, or *Concrete Machinery Co.*

Respondent next argues that the issue of separability in this case was adequately addressed by a jury instruction. Respondent's Brief in Opposition at 12-13. But separability, whether the idea and expression merge so as to preclude copyrightability, is a question of law for the court. *Hart*, --- F.3d at ---, 1996 WL 346330 at *3; *Country Kids*, 77 F.3d at 1287-88; *Concrete Machinery Co.*, 843 F.2d at 608-09. It is not a matter for submission to the jury.

The record fails to show a separability analysis of the type contemplated by the law in other circuits. In its absence, there was no proper determination that the mannequins at issue were copyrightable. Moreover, the reliance of the court below on mere "argument" and "belief", Pet.App. 25a; 74 F.3d at 494, rather than searching analysis, shows a marked departure from the practice of other circuits in the application of the Copyright Act.

II. The Circuits Have Decisively Split on the Issue of Copyrightability.

In applying the same law to the same or similar articles, the courts in this case, in *Hart*, and in *Country Kids* reach three different conclusions on copyrightability.

Country Kids involved wooded dolls modeled after traditional paper dolls. 77 F.3d at 1282. The court affirmed the district court's holding that the medium, size and shape of the dolls are not copyrightable features:

> [N]ot only is the idea of a wooden doll not copyrightable, but any basic and utilitarian aspects of the dolls, such as the shape of a human body and standard paper doll poses which are both friendly and inviting and also utilitarian for their ease of manufacture and adaptability to the attachment of various wardrobes, cannot be copyrighted.

Id. at 1287. The taxidermy mannequins here are not

copyrightable under the analysis in *Country Kids*. The shape of the mannequin is dictated by the shape of the body of the animal and by adaptability to mounting skins. In contrast, the court in *Hart* rejected the argument that utilitarian features made taxidermy mannequins non-copyrightable.

Petitioner initially argued here that the decision in *Carol Barnhart* was authority for the proposition that taxidermy mannequins are useful articles and hence not copyrightable. In the *Hart* decision, the court confronted the identical argument and squarely held that taxidermy mannequins are copyrightable despite their utilitarian features. --- F.3d at ---, 1996 WL 346330 at *4. This ruling disposed of the argument that the Second Circuit would hold that mannequins were non-copyrightable useful articles. But in so holding, partly on the authority of the opinion below, the *Hart* court created another conflict.

The court below concluded that ordinary taxidermy mannequins are not copyrightable. Pet.App. 21a-22a; 74 F.3d at 493. The one analysis of separability that the court below did conduct led it to conclude that ordinary mannequins lack the requisite originality of expression. *Id.* The court held that, as to such mannequins, the idea and expression are identical and inseparable. *Id.* The mannequins in this case were only copyrightable because they were created by sculpting rather than the usual process of casting directly from animal carcasses. *Id.* In effect, this ruling allowed the question of copyrightability to turn on a non-copyrightable element. The Copyright Act protects neither the idea, nor any procedure, process, system, method of operation, or concept, regardless of the form in which it is embodied in the work. 17 U.S.C. § 102(b). *See also Country Kids*, 77 F.3d at 1285.

That two Circuit Court of Appeals would reach opposite conclusions in applying the same law to the same article, indeed, to the same party, evidences a dramatic divergence in the understanding and consistent application of federal law. Merchants like the Petitioners operate on a national scale. The notion that they operate under a uniform federal law of copyright threatens to become a fiction.

CONCLUSION

The argument of Respondents that there is no split between the circuits in the application of the Copyright Act cannot be maintained in the face of the recent decisions *Hart* and *Country Kids*. This case provides the Court the means to take up these issues and clarify the correct application of the law. Otherwise, the law of copyright will continue to develop inconsistently. Contrary to its purpose of providing a consistent national rule, the Copyright Act will become an uncertain and capricious guide to those seeking to conform their conduct to the law.

WHEREFORE, the Petitioners respectfully request that the petition for writ of certiorari be granted.

Respectfully submitted,

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